

Remarks

Applicants wish to thank the Examiner for the courtesies extended to the undersigned during the telephone interview on May 27, 2003. An Interview Summary accompanies this response.

Applicants hereby add new claims 20-26 and cancel claim 9. Accordingly, claims 1-8 and 10-26 are pending in the present application.

Claims 1, 2, 5-8, 11-14, and 17-19 stand rejected under 35 USC 103(a) for obviousness over European Patent No. EP0917042 to Leong et al. and further in view of U.S. Patent No. 5,935,262 to Barrett et al. Claims 3-4, 9-10, and 15-16 stand rejected under 35 USC 103(a) for obviousness over Leong et al. in view of Barrett et al. and further in view of *LAN Attached and UNIX Printing for VINES® Administrator's Manual*, by Incognito Software Inc., (ISI).

Applicants respectfully traverse the rejections and urge allowance of the present application.


Referring to claim 1, it is stated on page 3 of the Action that Leong fails to teach or suggest a resource agent for receiving job result information. Page 4 of the Action states that Barrett teaches the resource agent for receiving job result information returned from the resource. Applicants disagree.

Teachings in the Abstract and columns 1 and 2 of Barrett have been identified as allegedly teaching the resource agent for receiving job result information returned from the resource. Such teachings were discussed during the telephone interview. In particular, the Examiner indicated the error information recited in col. 2 of Barrett implies communication from the printer to the network device of Barrett. Applicants submit the Barrett teachings fail to disclose or suggest limitations of Applicants' claim 1.

More specifically, Applicants refer the Examiner to col. 10, lines 15-20 of Barrett wherein it is clearly stated that limited amounts of status information are received by NED 1001 from printer 102. It is stated that the interface of the NED 1001 "only includes four dedicated printer status lines, a "busy" status line, a "paper out" status line, an "I/O error" status line and an "online/offline" status line." Emphasis added.

Applicants note such Barrett teachings regard the status of the printer. To the contrary, claim 1 positively recites a *resource agent for receiving job*

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result information returned from the resource wherein the job result information identifies the results achieved by the resource in response to the resource job.

The teachings of Barrett are explicitly limited to only providing printer status information and provide absolutely no identification of results achieved by the resource in response to the resource job as claimed. The error information conveyed by the printer is responsive to conditions of the printer independent of a resource job and in no fair interpretation may be fairly construed to disclose or suggest job result information achieved by the resource in response to the resource job as defined in claim 1.

Further, claim 1 specifically defines job result information identifies results **achieved by the resource** in response to the resource job. The error information of Barrett will never permit the printer of Barrett to achieve results. For example, nothing can be achieved if the printer is "busy," "out of paper," has an "I/O error," or is "offline." There is absolutely no job result information from a resource identifying results achieved by the resource in response to the resource job and claim 1 is allowable for at least this additional reason.

Claim 1 also defines a *resource collector* for receiving the ***job result information*** and generating corresponding **job detail information representing system resources used in executing the resource job**. The teachings of the art taken alone or in combination fail to disclose or suggest the claimed resource collector. Barrett only provides communication of printer status information (i.e., off line, busy, printer out, I/O error) and the printer of Barrett fails to communicate any information which may be used to generate corresponding ***job detail information representing system resources used in executing the resource job***. Numerous limitations of claim 1 are not shown nor suggested by the art and claim 1 is allowable.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. See, e.g., MPEP §2143 (8th ed.). The prior art rejection of claim 1

is improper at least in view of the deficiencies of the combined reference teachings noted above.

Applicants further submit there is no motivation to combine the reference teachings and the 103 rejection of claim 1 is improper for this additional reason. In particular, page 4 of the Office Action baldly presents conclusory reasons for combining the reference teachings. Applicant disagrees with the presented motivational rationale.

Leong is concerned with two problems as set forth in col. 2, lines 23-40 of accepting a print job and assigning a print job to another device. Leong's solutions to accepting print jobs and assigning print job are not concerned with predicting maintenance or resupply or diagnosing problems. The mere fact that references *can* be combined or modified does not render the resultant combination obvious *unless the prior art also suggests the desirability of the combination*. MPEP §2143.01 citing *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990).

The Federal Circuit discussed proper motivation *In re Lee*, 61 USPQ 2d 1430 (Fed. Cir. 2002). The motivation identified in the Office Action is akin to the conclusory statements set forth in *In re Lee* which were found to fail to provide the requisite motivation to support an obviousness rejection. The Court in *In re Lee* stated the factual inquiry whether to combine references must be through and searching. It must be based on objective evidence of record. The Court in *In re Fritch*, 23 USPQ 2d 1780, 1783 (Fed. Cir. 1992) stated motivation is provided only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references. The *Lee* Court stated that the Examiner's conclusory statements in the *Lee* case do not adequately address the issue of motivation to combine. The Court additionally stated that the factual question of motivation is material to patentability and can not be resolved on subjective belief and unknown authority. The Court also stated that deficiencies of cited references cannot be remedied by general conclusions about what is basic knowledge or common sense. The Court further stated that the determination of patentability must be based on evidence.

In the instant case, the record is entirely devoid of any evidence to support motivation to combine the teachings apart from the bald conclusory statements of the Examiner which are insufficient for proper motivation as set forth by the Federal Circuit. The Office cannot rely on conclusory statements when dealing with particular combinations of prior art and specific claims but must set forth rationale on which it relied. Statements set forth in the present Office Action are akin to the alleged motivation discussed *In re Lee* and accordingly are insufficient to combine the reference teachings. The 103 rejection of claim 1 is improper without the proper motivation and Applicant respectfully requests allowance of claim 1 in the next action.

According to the motivational rationale presented in the Office Action, any teachings of a secondary reference may be combined with the teachings of a primary reference if an improvement is provided. Applicant submits the *Lee* case clearly illustrates such an interpretation is improper, conclusory, and not in compliance with the MPEP for establishing a proper *prima facie* case of obviousness.

The claims which depend from independent claim 1 are in condition for allowance for the reasons discussed above with respect to the independent claim as well as for their own respective features which are neither shown nor suggested by the cited art.

Referring to claim 7, the teachings of the prior art taken alone or in combination fail to disclose or suggest the claimed resource agent for *receiving job result information returned from the printer and the job result information identifies the results achieved by the printer in response to the print job*. Further, the prior art teachings are incapable of *receiving job result information* and generating corresponding *job detail information representing system resources used in executing a print job*. Claim 7 is allowable for at least these reasons.

Claim 7 further recites a dynamic discovery function for identifying a current location of a current resource collecting server on the network and for *transmitting job result information to the current resource collecting server*. It is alleged on page 10 of the Action that ISI teaches a dynamic discovery function for identifying a current location of a UNIX queue. Claim 7 specifically recites

the dynamic discovery function for identifying the location of the current resource collecting server and transmitting job result information to the current resource collecting server. The identification of the UNIX queue fails to disclose or suggest the claimed identifying and transmitting job result information. Further, Barrett merely discloses outputting a log file to the image forming apparatus as set forth in col. 2, lines 40-41 which fails to disclose or suggest the *dynamic discovery function and transmitting job result information to the current resource collecting server identified by the dynamic discovery function*. Claim 7 recites limitations not shown nor suggested by the prior art and claim 7 is allowable.

The claims which depend from independent claim 7 are in condition for allowance for the reasons discussed above with respect to the independent claim as well as for their own respective features which are neither shown nor suggested by the cited art.

Referring to claim 13, the prior art fails to disclose or suggest returning *job result information from the resource receiving the resource job* to the resource server wherein the *job result information identifies the results achieved by the resource in response to the resource job*. The prior art further fails to disclose or suggest *forwarding the job attribute information and job result information returned from the resource to a collecting server*. The teachings of Barrett regarding forwarding the log file to the resource fail to disclose or suggest the claimed forwarding. The prior art teachings regarding Busy, I/O failure, Off-line, or Paper Out fail to disclose or suggest *generating job detail information representing system resources used in executing the resource job*. Numerous positively-recited limitations of claim 13 are not shown nor suggested by the art and claim 13 is allowable for at least this reason.

The claims which depend from independent claim 13 are in condition for allowance for the reasons discussed above with respect to the independent claim as well as for their own respective features which are neither shown nor suggested by the cited art.


Applicants hereby add new claims 20-26. Support for the new claims may be found at least at page 7 lines 7-31 of the originally-filed application. The new claims are allowable over the prior art.

Applicants respectfully request allowance of all pending claims.

The Examiner is requested to phone the undersigned if the Examiner believes such would facilitate prosecution of the present application. The undersigned is available for telephone consultation at any time during normal business hours (Pacific Time Zone).

Respectfully submitted,
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By: _____


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